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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/046,300	01/16/2002	Syuuji Matsuura	0033-0785P	2317

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EXAMINER	
LAMBRECHT, CHRISTOPHER M	
ART UNIT	**PAPER NUMBER**
2611	

DATE MAILED: 10/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No.	Applicant(s)	
	10/046,300	MATSUURA, SYUUJI	
	Examiner	Art Unit	
	Christopher M. Lambrecht	2611	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

a) ☒ The period for reply expires *4* months from the mailing date of the final rejection.

b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.

2. ☒ The proposed amendment(s) will not be entered because:

   (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);

   (b) ☐ they raise the issue of new matter (see Note below);

   (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

   (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: *See Continuation Sheet*.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.

4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5. ☒ The a)☐ affidavit, b)☐ exhibit, or c)☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: *See Continuation Sheet*.

6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7. ☒ For purposes of Appeal, the proposed amendment(s) a)☒ will not be entered or b)☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

   The status of the claim(s) is (or will be) as follows:

   Claim(s) allowed: _____.

   Claim(s) objected to: _____.

   Claim(s) rejected: *1 and 7*.

   Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a)☐ approved or b)☐ disapproved by the Examiner.

9. ☐ Note the attached Information Disclosure Statement(s)(PTO-1449) Paper No(s). _____.

10. ☐ Other: _____

CHRIS GRANT
PRIMARY EXAMINER

Continuation of 2. NOTE: Amendment to claim 1 recites "transmitting a control signal to said at least one power amplifying circuit". This limitation raises new issue and consequently requires further consideration.

Continuation of 5. does NOT place the application in condition for allowance because: In the response filed 19 August 2004, Applicant disputes the rejections under 35 U.S.C. §103(a) of independent claim 7 as set forth the final Office action mailed 28 April 2004.
In particular, Applicant submits the following:
(a) the variable gain amplifier in Abe fails to correspond to at least one power amplifying circuit for power amplifying a data signal that is gain controlled by a gain control circuit (p. 9);
(b) Vorenkamp fails to disclose "a SAW filter for selecting the first intermediate frequency signal output from said up converter" and then converting the selected signal from the SAW filter by a "down converter" to a "second intermediate frequency signal of lower frequency for output" (p. 9);
(c) the SAW filter in Shahar (of record) does not select a "first intermediate frequency signal output from said up converter" so that a down converter converts "the first intermediate frequency signal selected by said SAW filter to a second intermediate frequency signal of lower frequency for output" (p. 10);
(d) Johannes (of record) does not make up for the deficiencies of Abe, Vorenkamp, and Shahar (p. 10);
(e) the Examiner has failed to establish a prima facie case of obviousness of independent claim 7 (p. 10); and,
(f) the Examiner's conclusions in claim 7 are based on improper hindsight reasoning (p. 11).
In response to (a), it is noted that the features upon which applicant relies (i.e., "at least one power amplifying circuit for power amplifying a data signal that is gain controlled by the gain control circuit") are not recited in the rejected claim. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See In re Van Geuns, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).
In response to (b), one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See In re Keller, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); In re Merck & Co., 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).
In response to (c), Shahar was not relied upon to teach a SAW filter that selects a "first intermediate frequency signal output from said up converter" so that a down converter converts "the first intermediate frequency signal selected by said SAW filter to a second intermediate frequency signal of lower frequency for output." Rather, as stated in the rejection of claim 7 in the final Office action, Vorenkamp teaches a filter "for selecting the first intermediate frequency output from said up converter" and then converting the selected signal from the filter by a "down converter" to a "second intermediate frequency signal of lower frequency for output." Therefore, Vorenkamp discloses the subject matter in question, including the use of a filter for performing the described functionality. What Vorenkamp does not explicitly disclose is that the filter is a SAW filter. Shahar suggests the use of a SAW filter for the benefit of lowering costs. Hence, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a SAW filter to perform the filtering functions recited by Vorenkamp, for the purpose of lowering costs (see rejection of claim 7).
In response to (d), Examiner submits that in view of the above remarks, the issues raised with respect to Abe, Vorenkamp, and Shahar have been alleviated, and, when taken in combination with Johannes makes obvious the inclusion of a SAW filter formed of an oscillator circuit including a print coil, for the purpose of providing high stopband rejection (see rejection of claim 7).
In response to (e), Examiner submits that all of the above issues have been alleviated, and consequently, the Examiner has established a prima facie case of obviousness of claim 7.
In response to (f), that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See In re McLaughlin, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).